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1 UNITED STATES PATENT AND TRADEMARK OFFICE
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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6
7

8 *Ex parte* VINCENT FORMALE, MARKUS KOESTLER,
9 JAMIE RANDOLPH, GEETIKA SHINDE, ANDREE TAYLOR,
10 GERALD TIESKOETTER, and LAGRAY WELLS
11

12 Appeal 2009-007225
13 Application 10/083,170
14 Technology Center 3600
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17
18 Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and
19 BIBHU R. MOHANTY, *Administrative Patent Judges*.
20 FETTING, *Administrative Patent Judge*.

21 DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE²

Vincent Formale, et al. (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1-30, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

The Appellants invented an asset management system, based on an automated web-based method, system, and Graphical User Interface (GUI) for managing the inventory and disposition of property in a corporate or other large-entity environment. (Specification 1:5-8).

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

1. A method of managing assets controlled by members of an organization, said organization having a central server configured to access data and software systems of said organization, comprising the steps of:

[1] identifying one or more of said assets for management and submitting an asset disposition request to said central server;

[2] at the central server,

² Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed June 23, 2008) and Reply Brief ("Reply Br.," filed November 18, 2008), and the Examiner's Answer ("Ans.," mailed September 18, 2008).

1 automatically,
2 based on receipt of said asset disposition request,
3 obtaining all required approvals for said asset disposition
4 request;

5 [3] at the central server,
6 automatically,
7 based on said obtaining of all required approvals,
8 effecting said asset disposition request; and

9 [4] at the central server,
10 automatically
11 modifying said data to reflect said effected disposition
12 request.

13
14 The Examiner relies upon the following prior art:

15 *Stanford University Property Administration Manual*, 7 Disposition 1,
16 <http://www.stanford.edu/dept/UPA/chapter%207.html>. (last visited Sept. 1,
17 2010)(hereinafter, Disposition).

18 Claims 2, 3, and 6-10 stand rejected under 35 U.S.C. § 101 as directed to
19 non-statutory subject matter.

20 Claims 11-20 stand rejected under 35 U.S.C. § 112, second paragraph, as
21 failing to particularly point out and distinctly claim the invention.

22 Claims 1-30 stand rejected under 35 U.S.C. § 102(b) as anticipated by
23 Disposition.

24 ISSUES

25 The issue as to statutory subject matter hinges on whether the dependent
26 claims incorporate the statutory subject matter of the parent claim. The issue
27 of indefiniteness hinges on whether the Specification and Drawings describe

1 structure that covers the functions in means plus function claims. The issue
2 of novelty hinges on what level of automation is recited in the claims and
3 whether the steps recited in the claims are performed as a central server in
4 the prior art.

5 FACTS PERTINENT TO THE ISSUES

6 The following enumerated Findings of Fact (FF) are believed to be
7 supported by a preponderance of the evidence.

8 *Facts Related to Appellants' Disclosure*

9 01. Assets are identified for disposition by an operator manually
10 indicating that an asset is to be disposed of. Specification 7:19-
11 8:4.

12 02. Approvals are indicated by approving officials' manually
13 entering approval on forms. Specification 9:14 -10:6.

14 03. Effecting dispositions occurs as a result of human operators
15 entering information in a graphical user interface. Specification
16 10:7-12:9.

17 *Facts Related to the Prior Art - Disposition*

18 04. Disposition is directed to procedures used at Stanford
19 University for disposing of fixed assets. Disposition 2: Overview.

20 05. Disposition uses a software package, Capital Asset
21 Management System (CAMS) implemented on Oracle Fixed
22 Assets for disposing of fixed assets. Disposition 2: Overview.
23 Oracle is a database company.

06. Disposition describes identifying assets for disposal, submitting
a disposition request, obtaining required approvals, effecting the
disposition request and updating the records accordingly.
Disposition 5:16 – 7:42 and Table on pp. 11-12.

ANALYSIS

*Claims 2, 3, and 6-10 rejected under 35 U.S.C. § 101 as directed to non-
statutory subject matter.*

Claim 1 is the sole independent claim. The Examiner has not rejected
claim 1. As the Appellants point out (Reply Br. 9), the claims rejected
incorporate the subject matter of claim 1. Thus, the Examiner erred in
rejecting the dependent claims when their parent claim recited statutory
subject matter.

*Claims 11-20 rejected under 35 U.S.C. § 112, second paragraph, as failing
to particularly point out and distinctly claim the invention.*

The only independent claim in this group, claim 11, includes means for
identifying assets and submitting a request, means for automatically
obtaining approvals, means for automatically effecting the request, and
means for automatically modifying data. The Examiner found that the
Specification failed to disclose structure covering the means recited in these
means plus function claims. Ans. 4. The Appellants contend that Fig. 11 in
the originally filed disclosure provides a flow chart that shows an
algorithmic structure covering these means. Reply Br. 10.

When a claim uses the term “means” to describe a limitation, a
presumption inheres that the inventor used the term to invoke 35 U.S.C. §

1 112, paragraph 6. *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1375 (Fed.
2 Cir. 2003). “This presumption can be rebutted when the claim, in addition to
3 the functional language, recites structure sufficient to perform the claimed
4 function in its entirety.” *Id.* Once a court concludes that a claim limitation is
5 a means-plus-function limitation, two steps of claim construction remain: 1)
6 the court must first identify the function of the limitation; and 2) the court
7 must then look to the specification and identify the corresponding structure
8 for that function. *Med. Instrumentation & Diagnostics Corp. v. Elekta AB*,
9 344 F.3d 1205, 1210 (Fed. Cir. 2003).

10 “If there is no structure in the specification corresponding to the
11 means-plus-function limitation in the claims, the claim will be found invalid
12 as indefinite.” *Biomedino, LLC v. Waters Technologies Corp.*, 490 F.3d 946,
13 950 (Fed. Cir. 2007); *see also In re Donaldson*, 16 F.3d 1189, 1195 (Fed.
14 Cir. 1994) (en banc).

15 In *Aristocrat Techs. Austl. Pty Ltd. v Inter. Game Tech.*, 521 F.3d 1328,
16 1333 (Fed. Cir. 2008), the court set forth that for a claim to a programmed
17 computer, a particular algorithm may be the corresponding structure under
18 § 112, sixth paragraph:

19 For a patentee to claim a means for
20 performing a particular function and then to
21 disclose only a general purpose computer as the
22 structure designed to perform that function
23 amounts to pure functional claiming. Because
24 general purpose computers can be programmed to
25 perform very different tasks in very different ways,
26 simply disclosing a computer as the structure
27 designated to perform a particular function does
28 not limit the scope of the claim to “the
29 corresponding structure, material, or acts” that

perform the function, as required by section 112
paragraph 6.

In two other recent cases, the Federal Circuit followed *Aristocrat* in holding means-plus-function claims invalid for indefiniteness for lack of sufficient description of algorithms to transform a general purpose computer to a special purpose of computer under 35 U.S.C. § 112, sixth paragraph. See *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1340-41 (Fed. Cir. 2008) and *Net Moneyin, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1367 (Fed. Cir. 2008).

Thus the issue is whether the flow chart in Fig. 11 describes an algorithmic structure for performing the recited functions. We find Fig. 11 does not. Fig. 11 is simply a series of boxes connected serially in which each contains the name of a function. The sole support for the means for identifying assets and submitting a request are blocks 1101 and 1107, replicating those functions, without disclosing structure as to how those functions are performed. Similarly only support for the means for automatically obtaining approvals is blocks 1108 which says only “Form Generated Approval Routing” with no structure as to how such routing occurs. There are no blocks corresponding to means for automatically effecting the request, and means for automatically modifying data. Although Figure 11 is further described at Specification 12-14, this portion only further elaborates on the function, such as exemplary sources of approval, without describing physical or algorithmic structure for implementing the functions. Thus, we find that there is no description of structure covering the means for the functions recited in claim 11 and its dependent claims.

*Claims 1-30 rejected under 35 U.S.C. § 102(b) as anticipated by
Disposition.*

The Examiner found that Disposition described all of the limitations in the independent claims. Ans. 9. The Appellants contend Disposition performs some functions manually and fails to show a central server that automatically performs the recited functions. Appeal Br. 6-10; Reply Br. 4-8.

It is uncontested that Disposition describes the steps absent the modifier “automatically.” Indeed, Disposition lays out a procedure that includes these steps. FF 06. Similarly it is uncontested that Disposition describes a server, as an Oracle based database package is used to implement the procedure and Oracle is known to produce database packages relying on servers. FF 05. The arguments are that more than one server is used; that operations are performed at terminals in addition to the server; and that much of Disposition is performed manually. Thus we come down to the issue of claim construction.

As to the issue of whether a single server is used, we find that a server is not necessarily constrained to one physical machine; it may be a singular functional structure whose implementation is spread over several subservient machines operating cooperatively, as in a database server that is spread over multiple computers. While each computer may be labeled a server as well, the composite forms a single server that serves client requests. The claim makes no structural limitations on the server configuration. As to the issue of performing tasks “automatically,” although this term may mean absent human intervention, some of the steps in the claim clearly require some

human intervention. Obtaining approval requires a human indicating approval. FF 02. Effecting disposition requires human indication of which manner of disposition (FF 03) and physical transference. Therefore, the word “automatically” must mean with the aid of automation rather than without human intervention. Clearly all of the steps performed by Stanford’s disposition procedure are done with the aid of CAMS. FF 04. None of the steps specify which portions of how each step is implemented are done automatically.

CONCLUSIONS OF LAW

Rejecting claims 2, 3, and 6-10 under 35 U.S.C. § 101 as directed to non-statutory subject matter is in error.

Rejecting claims 11-20 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention is not in error.

Rejecting claims 1-30 under 35 U.S.C. § 102(b) as anticipated by Disposition is not in error.

DECISION

To summarize, our decision is as follows.

- The rejection of claims 2, 3, and 6-10 under 35 U.S.C. § 101 as directed to non-statutory subject matter is not sustained.
- The rejection of claims 11-20 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention is sustained.

1 • The rejection of claims 1-30 under 35 U.S.C. § 102(b) as anticipated
2 by Disposition is sustained.

3 No time period for taking any subsequent action in connection with this
4 appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.
5 § 1.136(a)(1)(iv) (2007).

6

7 AFFIRMED

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11 mev

12

13 Address

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